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INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

EXAMINER

ELAHEE, MD S

ART UNIT	PAPER NUMBER
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2614

MAIL DATE	DELIVERY MODE
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07/02/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/843,145

Applicant(s)

PRADHAN ET AL.

Examiner

Md S. Elahee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04/04/2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-12, 14, 20-22 and 25-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5, 7-12, 14, 20-22, 25-37 and 39-41 is/are rejected.
- 7) ☒ Claim(s) 12 and 38 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is responsive to an amendment filed 04/04/2007. Claims 1-5,7-12,14,20-22 and 25-41 are pending. Claim 13 has been previously cancelled. Claims 38-41 have been newly added.

Response to Arguments

2. The arguments filed in the 04/04/2007 Remarks have been fully considered but they are not persuasive because of the following:

The applicant argues on page 9, "The Office Action includes an alleged quote from the Manual of Patent Examining Procedure (MPEP), but does not provide the MPEP § from which the quote is obtained". Examiner agrees with this argument. For quote, "If the application properly claims benefit under 35 U.S.C. 119(e) to a provisional application, the effective filing date is the filing date of the provisional application for any claims which are fully supported under the first paragraph of 35 U.S.C. 112 by the provisional application" see **MPEP 706.02[R-3]** under section V and for quote, "In applications claiming priority under 35 U.S.C. 119(e), a statement such as "This application claims the benefit of U.S. Provisional Application No. 60/ - - -, filed - --" should appear as the first sentence>(s)< of the specification or in an application data sheet" see **MPEP 13.06** under section "Examiner Note".

Regarding claim 1, the Applicant argues on page 10 that "If the Examiner is relying on this provision of the MPEP, he has a burden to prove that the claims of publication

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2002/0161674 are fully supported by the provisional application". Examiner respectfully disagrees with this argument. According to quote, "If the application properly claims benefit under 35 U.S.C. 119(e) to a provisional application, the effective filing date is the filing date of the provisional application for any claims which are fully supported under the first paragraph of 35 U.S.C. 112 by the provisional application", examiner needs to show any claims of the provisional application which are fully supported under the first paragraph of 35 U.S.C. 112 by the provisional application. For example for claim 1 of publication 2002/0161674, see page 4-8 of summary of the provisional application.

The applicant further argues on page 12 that "The Examiner has the burden of proving that the provisional application includes a statement that is the same as or similar to the statement of paragraph 256 of the published application, the only portion of the Scheer published application on which the Examiner relies". In page 19 of "MRO ISCM - Intelligent Agent Architecture" section 11 of the provisional application, the provisional application includes a statement that is the same as or similar to the statement of paragraph 256 of the published application.

The Applicant further argues on page 12 that in paragraph 0256 of **Scheer**, there can be no change in the message data that the broker device sends to the advertiser device because the broker device sends exactly the same message data to the distributor agent that the broker received. Examiner respectfully disagrees with this argument. The examiner depend upon **Scheer** only for the teaching of changing message data of the reply at the broker device. In paragraph 0256, **Scheer** discloses, after receiving "subscribe" performative, the broker sets up an entry to service this request. In reply to this request, the broker prepares status change messages and inform the distributor to send the status change messages. Therefore, it is clear that **Sheer**

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teaches changing message data of the reply at the broker device. Thus, the rejection of the claims in view of **Rautila** and **Scheer** will remain.

Regarding claims 27-29, the Applicant argues on pages 13-14 that the requirements for claims 27-29 are not found in Rautila et al. Examiner respectfully disagrees with this argument. The requirements are found in col.7, lines 1-10 of Rautila. Thus, the rejection of the claims in view of **Rautila** and **Scheer** will remain.

Regarding claim 1, the Applicant argues on page 15 that Todd does not disclose communicating a changed reply message at a broker device and communicating the changed reply message from the broker device to the advertiser device. Examiner didn't rely upon Todd for the teaching of communicating a changed reply message at a broker device and communicating the changed reply message from the broker device to the advertiser device. Instead examiner relied upon **Todd** for the teaching of changing message data of the reply at the broker device (see col.5, lines 58-64). Therefore, the rejection of the claims in view of **Rautila** and **Todd** will remain.

Regarding claim 20, the Applicant argues on page 8 that **Konishi** has nothing to do with an advertiser or a repplier to an advertisement. Examiner respectfully disagrees with this argument. **Konishi** teaches response message corresponding to a transmitted message [i.e., advertisement] (see col.2, lines 55-57). Therefore, the rejection of the claims in view of **Rautila** and **Konishi** will remain.

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3. Applicant's arguments regarding claims 31, 39 Remarks have been fully considered but are moot in view of the new ground(s) of rejection which is deemed appropriate to address all of the needs at this time.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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7. Claims 1-5, 7-11, 14, 27-31, 33 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rautila et al. (U.S. 6,549,625) in view of Scheer (U.S. 2002/0161674).

As to Claims 1, 27-30, with respect to Figures 1-4, Rautila teaches a method of advertising comprising:

broadcasting an advertisement via a short range link from an advertiser telecommunications device, 14, (Figure 1, labels 12,14);

receiving the broadcast advertisement on a consumer telecommunications device, 12, (Figure 1, label 12);

replying to the advertisement by sending a SMS message (reply message including message data) from the consumer device to a broker device, 26 (Figure 1, label 26 and Col. 7, lines 1-10);

changing the SMS message to an acknowledgment message (reply message) at the broker device to derive a changed reply message (Col. 7, lines 1-10);

communicating the acknowledgement (changed reply) from the broker device to the advertiser device (Col. 7, lines 1-10).

However, Rautila does not specifically teach “changing message data of the reply at the broker device”. Scheer teaches changing message data of the reply at the broker device (page 26, paragraph 0256). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rautila to change message data of the reply at the broker

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device as taught by Scheer. The motivation for the modification is to have doing so in order to deliver a updated message in response to a request of the recipient whenever he needs.

As to Claim 2, Rautila teaches a method according to claim 1 in which the advertisement is broadcast to a man portable consumer device (Figure 1, label 12).

As to Claim 3, Rautila teaches a method according to claim 2 in which the consumer telecommunications device is a hand-holdable portable and pocketable device (Figure 2).

As to Claim 4, Rautila teaches a method according to claim 1 in which the advertisement is broadcast from a man portable advertiser device (Figure 1, label 14).

As to Claim 5, Rautila teaches a method according to claim 4 in which the advertiser device is a hand-holdable portable device (Figure 1, label 14).

As to Claim 7, Rautila teaches a method according to claim 1 in which the advertiser device does not include its own telecommunications address in its broadcast advertisement (Figure 3 and Col. 6, lines 48-60 and Col. 8, lines 63-67).

As to Claim 8, Rautila teaches a method according to claim 7 further including the step of including the telecommunications address of the broker device in the advertisement (Col. 7, lines 12-22).

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As to Claim 11, Rautila teaches a method according to claim 1 in which the consumer device replies to an advertisement via long range telecommunications (Figure 1, label 42).

As to Claim 14, Rautila teaches a method according to claim 1 comprising using a mobile telephone, personal digital assistant, or other small portable electronic devices for both the advertiser device and the consumer device, the advertiser and consumer devices both having both piconet short range and long range telecommunication capabilities (Col. 6, lines 23-47).

Claim 31 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Rautila teaches a method according to claim 1, wherein the reply message communicated from the broker device to the advertiser device is changed by the broker device changing the message sent by the consumer device by augmenting the message in the reply message sent by the consumer device to the broker device (Col. 10, lines 1-8, 58-64 and Col. 5, lines 39-51).

As to Claim 33, Rautila teaches a method according to claim 1, further including transmitting additional advertisement information from the advertiser device to the consumer device in response to a request for additional information by the consumer device to the advertisement (Col. 10, lines 1-8, 58-64 and Col. 5, lines 39-51).

As to Claim 39, Rautila teaches a method according to claim 1, wherein the reply message communicated from the broker device to the advertiser device is changed by the broker device

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changing the message data sent by the consumer device by deleting some of the message data in the reply message sent by the consumer device to the broker device (Col. 10, lines 1-8, 58-64 and Col. 5, lines 39-51).

8. Claims 1-5, 7-11, 14, 27-31, 33 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rautila et al. (U.S. 6,549,625) in view of Todd (U.S. 6,785,682).

As to Claims 1, 27-30, with respect to Figures 1-4, Rautila teaches a method of advertising comprising:

broadcasting an advertisement via a short range link from an advertiser telecommunications device, 14, (Figure 1, labels 12,14);

receiving the broadcast advertisement on a consumer telecommunications device, 12, (Figure 1, label 12);

replying to the advertisement by sending a SMS message (reply message) from the consumer device to a broker device, 26 (Figure 1, label 26 and Col. 7, lines 1-10);

changing the SMS message to an acknowledgment message (reply) at the broker device (Col. 7, lines 1-10);

communicating the acknowledgement (changed reply) from the broker device to the advertiser device (Col. 7, lines 1-10).

However, Rautila does not specifically teach “changing message data of the reply at the broker device”. Todd teaches changing message data of the reply at the broker device (col.5, lines 58-

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64). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rautila to change message data of the reply at the broker device as taught by Todd. The motivation for the modification is to have doing so in order to deliver a modified message in response to a request of the recipient whenever he needs.

As to Claim 2, Rautila teaches a method according to claim 1 in which the advertisement is broadcast to a man portable consumer device (Figure 1, label 12).

As to Claim 3, Rautila teaches a method according to claim 2 in which the consumer telecommunications device is a hand-holdable portable and pocketable device (Figure 2).

As to Claim 4, Rautila teaches a method according to claim 1 in which the advertisement is broadcast from a man portable advertiser device (Figure 1, label 14).

As to Claim 5, Rautila teaches a method according to claim 4 in which the advertiser device is a hand-holdable portable device (Figure 1, label 14).

As to Claim 7, Rautila teaches a method according to claim 1 in which the advertiser device does not include its own telecommunications address in its broadcast advertisement (Figure 3 and Col. 6, lines 48-60 and Col. 8, lines 63-67).

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As to Claim 8, Rautila teaches a method according to claim 7 further including the step of including the telecommunications address of the broker device in the advertisement (Col. 7, lines 12-22).

As to Claim 11, Rautila teaches a method according to claim 1 in which the consumer device replies to an advertisement via long range telecommunications (Figure 1, label 42).

As to Claim 14, Rautila teaches a method according to claim 1 comprising using a mobile telephone, personal digital assistant, or other small portable electronic devices for both the advertiser device and the consumer device, the advertiser and consumer devices both having both piconet short range and long range telecommunication capabilities (Col. 6, lines 23-47).

Claim 31 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Rautila teaches a method according to claim 1, wherein the reply message communicated from the broker device to the advertiser device is changed by the broker device changing the message sent by the consumer device by augmenting the message in the reply message sent by the consumer device to the broker device (Col. 10, lines 1-8, 58-64 and Col. 5, lines 39-51).

As to Claim 33, Rautila teaches a method according to claim 1, further including transmitting additional advertisement information from the advertiser device to the consumer device in

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response to a request for additional information by the consumer device to the advertisement (Col. 10, lines 1-8, 58-64 and Col. 5, lines 39-51).

As to Claim 39, Rautila teaches a method according to claim 1, wherein the reply message communicated from the broker device to the advertiser device is changed by the broker device changing the message data sent by the consumer device by deleting some of the message data in the reply message sent by the consumer device to the broker device (Col. 10, lines 1-8, 58-64 and Col. 5, lines 39-51).

9. Claims 20, 21 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rautila et al. (U.S. 6,549,625) in view of Konishi (U.S. 5,301,273).

As to Claims 20, 21, 32 with respect to Figures 1-4, Rautila teaches a server with database 26 (server), the server including an arrangement adapted to act as an advertisement broker device adapted to receive an SMS message (one of (i) an advertisement message or (ii) a reply message to an advertisement) and to forward the received message to a mobile terminal (remote telecommunications device) (Col. 10, lines 1-8 and 55-64);

the arrangement being adapted to validate the user (modify the received message) so as to ensure, at least initially, that the mobile user is an authorized user to receive the additional information about the goods or service or other information sources (Col. 9, lines 15-20, 56-67, Col. 10, lines 1-8, 55-63).

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However, Rautila does not specifically teach the server to ensure, at least initially, that no telecommunications address of an advertiser or replier to an advertisement is passed with the message that is transmitted by the server". Konishi teaches the bridge unit (fig.1, item 20a, fig.2) [i.e., server] to ensure, at least initially, that no telecommunications address of an advertiser or replier to an advertisement is passed with the message that is transmitted by the server (abstract; col.2, lines 52-58). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rautila to incorporate the server to ensure, at least initially, that no telecommunications address of an advertiser or replier to an advertisement is passed with the message that is transmitted by the server as taught by Konishi. The motivation for the modification is to do so in order to remove an address from a message to be transmitted so that the message can be broadcasting again.

10. Claims 22, 25, 26, 37, 40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rautila et al. (U.S. 6,549,625) in view of Paltenghe et al. (U.S. 2001/0011250).

As to Claims 22, 40, 41, with respect to Figures 1-4, Rautila teaches a network comprising an advertiser device (fig.1, item 16, fig.3) comprising a first telecommunications device having both a short range transmitter and receiver (fig.1, item 14), and a long range telecommunication transmitter and receiver (fig.1, item 30, fig.3), a memory, and a control processor, the memory including all advertisement (fig.1; col.8, lines 5-13);

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a consumer device (fig.1, item 12) comprising a second telecommunications device, having both a short range, piconet, transmitter and receiver, and a long range telecommunications transmitter and receiver, a memory and a control processor, the memory or the processor of the consumer device having an advertisement receiver which in use, is capable of receiving and storing advertisement (fig.2);

a server with database 26 [i.e., an advertisement broker device] contactable via wireless telecommunications with both the advertiser and consumer devices, the broker device being adapted to selectively pass advertiser details to the consumer device, consumer details to the advertiser device, or both, in response to triggering (Col. 9, lines 15-20, Col. 10, lines 1-8, 55-64).

However, Rautila does not specifically teach that block passage of advertiser details to the consumer device". (Note; examiner considers the claimed "or" in line 8 of the claim 22 as simple alternative "or", therefore, examiner selects only the claimed "advertiser details to the consumer device"). Paltenghe teaches that block passage of advertiser details to the consumer device (col.5, lines 58-64). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rautila to block passage of advertiser details to the consumer device as taught by Paltenghe. The motivation for the modification is to have doing so in order to prevent direct contact between advertiser and consumer.

As to Claim 25, Rautila teaches the network of claim 22 in which the broker device is connectable with the advertiser device and the consumer device via long range wireless telecommunications (fig.1).

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As to Claim 26, Rautila teaches the network of claim 22 wherein each the telecommunication devices includes a hybrid telephone (Col. 8, lines 49-52).

As to Claim 37, Rautila does not specifically teach that block passage of address of the advertiser devices to the consumer device. Paltenghe teaches that block passage of address of the advertiser devices to the consumer device (col.5, lines 58-64). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rautila to block passage of address of the advertiser devices to the consumer device as taught by Paltenghe. The motivation for the modification is to have doing so in order to prevent direct communication between advertiser devices to the consumer device.

11. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rautila et al. (U.S. 6,549,625) in view of Paltenghe et al. (U.S. 2001/0011250) further in view of Konishi (U.S. 5,301,273).

Claim 34 is rejected for the same reasons as discussed above with respect to claim 20.

12. Claims 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rautila et al. (U.S. 6,549,625) in view of Scheer (U.S. 2002/0161674) further in view of Paltenghe et al. (U.S. 2001/0011250).

Claims 35 and 36 are rejected for the same reasons as discussed above with respect to claims 22 and 37 respectively.

13. Claims 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rautila et al. (U.S. 6,549,625) in view of Todd (U.S. 6,785,682) further in view of Paltenghe et al. (U.S. 2001/0011250).

Claims 35 and 36 are rejected for the same reasons as discussed above with respect to claims 22 and 37 respectively.

Allowable Subject Matter

14. Claims 12 and 38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

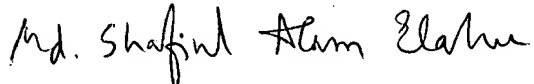
Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Md S. Elahee whose telephone number is (571) 272-7536. The examiner can normally be reached on Mon to Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MD SHAFIUL ALAM ELAHEE

June 25, 2007